

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Kelly J. Reasoner	Examiner: Michael E. Butler
Serial No.:	10/665,132	Group Art Unit: 3653
Filed:	September 16, 2003	Docket No.: 100201882-1
Title:	Inventory Control Device	

REPLY APPEAL BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed April 3, 2009, Appellants file this Reply Brief in accordance with 37 C.F.R. § 41.41.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

First, as recited in claim 1, when the latch is moved to a second position the data storage system performs an inventory of storage locations; and when the latch remains in the first position, no inventory is performed. In the Examiner Answer, the Examiner argues that Shiba teaches these claim elements:

In Shiba the device performs a read as a result of the latch position. Reading and building the table is a taking of the inventory within the broad scope of inventorying the contents become known. {See Examiner Answer at p. 8}.

Appellants respectfully disagree. Shiba is not performing an inventory of storage locations. Instead, Shiba is reading data from memory and forming a data table.

According to MPEP § 2111.01, the words of a claim must be given their “plain meaning.” Furthermore, Appellants acknowledge that claims must be given their broadest interpretation during patent examination. However, this interpretation must be a **“reasonable interpretation consistent with the specification”** (see MPEP 2111: emphasis added).

It is not reasonable to equate the teachings in Shiba with performing an inventory of storage locations as recited in claim 1. Appellants’ specification repeatedly uses the term “inventory” in a manner consistent with the plain meaning of this term. As explained in the background section, an inventory of data cartridges occurs after the system shuts down since cartridges in the storage library could have been exchanged, removed, or added while the data storage system was shut down. Figure 4 illustrates a method used to control inventory after a shut down. The specification discusses how an “inventory” is performed:

In one embodiment, the inventory may be performed by moving a cartridge access device to each of the storage locations that may have been accessed when access device 120 was opened so that the cartridge access device can read bar code labels of the data storage devices contained therein. The inventory list may then be updated with the information

obtained from the inventory of the storage locations. Other methods of performing the inventory may also be used. {See paragraph [0022] on pages 7 – 8}.

Shiba is reading data from memory and forming a data table, but is not perform an “inventory of storage locations” in accordance with the plain meaning of these terms.

Second, in the Examiner Answer, the Examiner argues that Goodman performs an inventory as recited in claim 1:

Goodman uses a sensor to sense position of a door and latches the data between states as a result of such movement. A re-inventorying takes place as a result of such sensed movement of the door monitoring switch which further has a flip-flop latch logic. {See Examiner Answer pages 8 – 9}.

Even assuming arguendo that Goodman performs an inventory of storage locations (which Appellants do not admit), Goodman and Chaloner still fail to teach or suggest numerous elements in claim 1. In the original Appeal Brief, Appellants did not argue that Goodman fails to teach performing an inventory of storage locations. Instead, Appellants argued the following:

- (1) Claim 1 recites a latch that moves from a first position to a second position. In other words, claim 1 recites an object (i.e., a latch) that moves between two positions. The Examiner argues that this element is taught in Goodman at column 12, lines 33-35. Appellants respectfully disagree.
- (2) Claim 1 recites an actuator that moves the latch from the second position to the first position. The Examiner argues that this element is taught in Goodman at column 11, line 65 to column 12, line 3. Appellants respectfully disagree.
- (3) Claim 1 recites that the actuator moves the latch from one position to another position. The Examiner equates the robot accessor in Goodman with the claimed actuator. The Examiner also equates the door monitoring switch in

Goodman with the claimed latch. Thus, the issue is: Does the robot accessor in Goodman move the door monitoring switch? It does not.

The Examiner Answer does not address these arguments. Instead, the Examiner Answer makes arguments regarding whether an inventory is being performed. Appellants have established that the combination of Goodman and Chaloner fail to make a prima facie case for obviousness.

Third, in the Appeal Brief, Appellants make various additional arguments that are not addressed in the Examiner Answer. For example, Appellants show that Goodman is not properly combinable with Reasoner in rejecting claims 1, 5-7, 9, and 11 under 35 U.S.C. 103(a). Appellants also show that Shiba is not properly combinable with Reasoner in rejecting claims 1, 5-7, 9, and 11 under 35 U.S.C. 103(a).

Appellants do not repeat all arguments provided in the original Appeal Brief but respectfully ask the BPAI to consider all such arguments.

In view of the above, Appellants believe that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Respectfully submitted,

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